

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

Formal Matters

Applicant requests that this amendment submitted under 37 CFR § 1.114 along with a Request for Continued Examination (RCE) be entered and the examination of the application be continued.

Claims 1 and 3-14 are the claims currently pending in the present Application. Claims 1 and 6 are amended; claim 2 had previously been canceled. In particular, independent claims 1 and 6 are amended to recite storing an image and a bookmark icon, and to further recite displaying the image as a bookmark image when the bookmark icon is selected. Support for this amendment can be found in the specification on page 16, lines 11-14.

Rejection of Claims 1 and 3-14 under 35 U.S.C. §103

Claims 1 and 3-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schena et al., U.S. Patent No. 6,546,418, in view of Dougherty et al., U.S. Patent No. 6,587,859. This rejection should be withdrawn based on the comments and remarks herein.

Schena teaches methods and apparatus for scanning machine-readable codes, such as barcode images, containing link information, such as a URL, and storing the codes in memory (abstract, column 7, lines 64-65). As the Examiner acknowledges, Schena does not teach displaying a scanned image on his apparatus. In addition, Schena does not teach or suggest storing a bookmark icon. Hence, Schena does not teach a memory that stores, or storing, both an image and a bookmark icon, and displaying the image when the bookmark icon is selected. The Examiner contends that it would have been obvious to one of ordinary skill in the art to

substitute a bookmark image for the images of Schena. However, applicant respectfully submits that because Schena does not teach or suggest displaying an image, Schena does not teach or suggest displaying an image *when the bookmark icon is selected* as recited in independent claims 1 and 6.

Dougherty does not overcome this deficiency, and the Examiner does not state otherwise. Dougherty teaches improving the human/computer interface by providing printable interfaces that enable a user to invoke and control computer processes (column 2, lines 53-55). Dougherty does not teach or suggest storing an image and a bookmark icon, and displaying the image when the bookmark icon is selected. Accordingly, independent claims 1 and 6 are patentably distinguish over the art of record in the application.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Schena and Dougherty does not teach or suggest storing an image and a bookmark icon and displaying the image when the bookmark icon is selected, and does not teach or suggest each and every feature of the present invention as recited in independent claims 1 and 6. Thus *prima facie* obviousness has not been established, so that these independent claims are distinguishable over the art of record in the application. Claims 3-5 depend from claim 1, and claims 7-14 depend from claim 6, each dependent claim incorporating all of the features and limitations of its base claim. Thus, these dependent claims are patentably distinguishable over the art of record in the application for at least the reasons that their base claims are patentably distinguishable over the art of record the application. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

In light of the foregoing, Applicant respectfully submits that all pending claims recite patentable subject matter, and kindly solicits an early and favorable indication of allowability. If the Examiner has any reservation in allowing the claims, and believes a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully submitted,



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